

REMARKS

This responds to the Office Action dated February 21, 2008.

Claims 1, 6-8 and 14-16 are amended, no claims are canceled, and no claims are added; as a result, claims 1-16 remain pending in this application. The amendments are merely for clarification purposes and are not related to patentability and are fully supported by the original claims of the application.

§103 Rejection of the Claims

Claims 1, 2, 4 and 6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Slezak (U.S. Patent No. 6,006,257) in view of Morrison (U.S. Patent No. 5,815,671).

For the reasons set forth below, Applicants respectfully submit that this rejection is improper, and the identified claims are non-obvious over Slezak in view of Morrison, and are therefore allowable. Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.¹

Claim 1 recites, in pertinent parts:

delivering set top box computer program code to a plurality of set top boxes, each set top box being associated with an upgraded advertising service subscriber;

providing indicators for at least two advertisements of said plurality of advertisements wherein said indicators include a priority level and a category for a corresponding advertisement;

broadcasting a video signal comprising program content, said plurality of advertisements, and said indicators for at least two advertisements of said plurality of advertisements to a plurality of set top boxes, wherein the set top box computer program code is to select one of the at least two advertisements based on said indicators.

(Emphasis added throughout)

The Office Action at page 3 concedes that Slezak does not disclose these limitations. However, the Office Actions, when discussing these limitations, relies on portions of Morrison to

¹ *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)

reject claim 1. Applicants disagree that Morrison in the cited passages discloses these limitations. Morrison in Figs. 3a & 3b and Table 1 shows Message Code Flags and Program Break Flags. Morrison, at col. 3, lines 16-34 and lines 39-48, states that “program materials are transmitted . . . to a multitude of receiving devices . . . Message material . . . are delivered to the receivers separately.”² However, the program material or the message material in the cited passage is not the same as the *computer program code*, as recited in claim 1. The program material in Slezak is clearly distinguished from the claimed *computer program code* which is to select one of the at least two advertisements based on said indicator, as recited in claim 1, because as Slezak states:

“A break in the program material for insertion of message material such as a commercial, is preceded by a program break flag of, for example, four bytes, inserted as auxiliary information transmitted and stored along with the program materials. In addition to using a program break flag to indicate an appropriate break in the program material for message material insertion . . .”³

According to the cited passage, commercial is inserted in a break in the program material. Clearly, a commercial could not be inserted in a break of a *computer program code* which is to select one of the at least two advertisements based on said indicator. Thus, Slezak does not disclose a *computer program code* which is to select one of the at least two advertisements based on said indicator, as recited in claim 1. Moreover, none of the cited portions from Morrison discloses delivering to a *plurality set top boxes, each set top box being associated with an upgraded advertising service subscriber*, as recited in claim 1. As such, Morrison in Figs. 3a & 3b, Table 1, and the cited passages does not teach or suggest the limitation of “*delivering set top box computer program code to a plurality of set top boxes, each set top box being associated with an upgraded advertising service subscriber, . . . wherein the set top box computer program code is to select one of the at least two advertisements based on said indicators*,” as recited in claim 1.

With regard to the second limitation “providing indicators . . .,” the Office Action relied on Morrison, at col. 3, lines 39-48 and col. 5, line 67- col. 6, line 5. Morrison, in the cited passages, discusses a program break flag and a message code flag and states that information is stored and accessed as a conventional hierarchical database:

² Morrison, col. 3, lines 15-34

³ Morrison, col. 3, lines 34-48

“ . . . using a program break flag to indicate an appropriate break in the program material for message material insertion, a message code flag contains message code data related to and identifying the message material to be inserted.”⁴

“The information is categorized, stored, and accessed as a conventional hierarchical database stored User interface 40 drives a hierarchy of menus to allow a user to access the information by indicating the desired selections from the menus.”⁵

According to the above passages, Morrison’s system uses a break flag to indicate break in the program material for message material insertion and a message code flag that contains code data identifying the message material. However, none of these flags could be construed as claimed *said indicators*, at least, because these flags do not include a priority level and a category for a corresponding advertisement, as required by claim 1. As such, the cited passages do not teach or suggest the feature of “*providing indicators for at least two advertisements of said plurality of advertisements wherein said indicators include a priority level and a category for a corresponding advertisement*,” as recited in claim 1.

Further, it accordingly stands to reason that in the absence of any teaching or suggestion of providing indicators for at least two advertisements in Morrison, there can be no teaching in this reference of the feature of “*broadcasting a video signal comprising program content, said plurality of advertisements, and said indicators for at least two advertisements of said plurality of advertisements to a plurality of set top boxes*,” as recited in claim 1.

Therefore, at least for the reasons set forth above, Morrison fails to teach or suggest the claim 1 limitations that are admittedly missing from Slezak. Therefore, Applicants respectfully submit that there are substantial differences between what is claimed and what the Office Action contends to be shown in Slezak and Morrison, whether they are considered separately or in combination. Because the cited documents do not show all of the elements of the claimed subject matter of claim 1, those differences are significant and non-obvious to a person of ordinary skill in the art at the time the application was filed. Furthermore, nothing in the disclosures of Slezak or Morrison provides a reason for a person of ordinary skill in the art to

⁴ Morrison, col. 3, lines 39-48

⁵ Morrison, col. 5, line 67-col. 6, line 5

seek to combine Slezak and/or Morrison in the manner suggested by the Examiner. As such, claim 1 and its dependent claims 2 and 4 are not rendered obvious by the proposed combination and thus are allowable.

Amended claim 6 recites, in pertinent part, “. . . wherein said advertisement indicators indicate a priority level and a category value” This feature was discussed above and it was shown that the feature is not disclosed by the combination of Slezak and Morrison. Thus, at least for the reasons articulated above with respect to claim 1, claim 6 is not rendered obvious by the combination and is allowable. As such, Applicants respectfully request the claim rejections under 35 U.S.C. § 103 (a) be withdrawn.

Claim 5 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Slezak (U.S. Patent No. 6,006,257) in view of Morrison (U.S. Patent No. 5,815,671) and Wachob (U.S. Patent No. 5,155,591).

Claim 5 is dependent on claim 1 and, thus, is deemed to include every limitation of the claim it is dependent on. As such, at least for the same reasons set forth above with respect to claim 1, claim 5 is not rendered obvious by the combination of Slezak and Morrison. Wachob is directed at broadcasting different commercial messages to different demographically targeted audiences in a cable television system or the like.⁶ However, Wachob fails to teach or suggest the features that were shown to be missing from the combination of Slezak and Morrison. As such, at least for the reasons noted above, claim 5 is not rendered obvious by the combination of Slezak, Morrison, and Wachob and, thus, is allowable.

Claim 3 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Slezak (U.S. Patent No. 6,006,257) in view of Morrison (U.S. Patent No. 5,815,671) and Eldering et al. (U.S. Patent Application Publication No. 2002/0083443A1, hereinafter “Eldering”).

Claim 3 is dependent on claim 1 and, thus, is deemed to include every limitation of claim 1. As such, at least for the same reasons articulated above with respect to claim 1, claim 3 is not rendered obvious by the combination of Slezak and Morrison. Eldering is directed at providing a

⁶ Wachob, Abstract

system and method for distributing advertisements (ads) in a television network, e.g., a cable-based network or a satellite network.⁷ However, Eldering fails to teach or suggest the features that were shown to be missing from the combination of Slezak and Morrison. As such, at least for the reasons noted above, claim 3 is not rendered obvious by the combination of Slezak, Morrison, and Eldering and, thus, is allowable.

Claims 7 and 14 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Slezak (U.S. Patent No. 6,006,257) in view of Morrison (U.S. Patent No. 5,815,671) and Goetz et al. (U.S. Patent No. 5,928,330, hereinafter “Gotez”).

The same arguments as presented with respect to claim 6 are also applicable to a consideration of claims 7 and 14. Thus, at least for the same reasons articulated above with respect to claim 6, claims 7 and 14 are not rendered obvious by the combination of Slezak and Morrison. Goetz is directed at providing a new file format for organizing related multimedia information and a system and device for, and method of, using the new file format.⁸ However, Goetz fails to teach or suggest the features that were shown to be missing from the combination of Slezak and Morrison. As such, at least for the reasons set forth above, claim 3 is not rendered obvious by the combination of Slezak, Morrison, and Goetz and, thus, is allowable.

Claims 8, 12, 13 and 15 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Slezak (U.S. Patent No. 6,006,257) in view of Morrison (U.S. Patent No. 5,815,671).

Claims 9 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Slezak (U.S. Patent No. 6,006,257) in view of Morrison (U.S. Patent No. 5,815,671).

The same arguments as presented with respect to claim 6 are also applicable to a consideration of independent claims 8 and 15. Thus, at least for the reasons set forth above with respect to claim 6, independent claims 8 and 15 and dependent claims 12 and 13 are not rendered obvious by the combination of Slezak and Morrison and, thus, are allowable.

Claims 10 and 11 were rejected under 35 U.S.C. § 103 (a) as being unpatentable over Slezak (U.S. Patent No. 6,006,257) in view of Wachob (U.S. Patent No. 5,155,591).

⁷ Eldering, Summary

⁸ Gotez, Summary

Claim 16 was rejected under 35 U.S.C. § 103 (a) as being unpatentable over Slezak (U.S. Patent No. 6,006,257) in view of Wachob (U.S. Patent No. 5,155,591).

The same arguments as presented with respect to claim 6 are also applicable to a consideration of claims 16. Thus, at least for the reasons set forth above with respect to claim 6, independent claim 16 is not rendered obvious by Slezak.

Claims 10 and 11 are dependent on claim 8, thus, are deemed to include the same limitations as claim 8. Therefore, at least for the same reasons articulated above with respect to claim 8, claims 10 and 11 are not rendered obvious by Slezak. Wachob is directed at broadcasting different commercial messages to different demographically targeted audiences in a cable television system or the like.⁹ However, Wachob fails to teach or suggest the features that were shown to be missing from Slezak. As such, Slezak and Wachob, individually or in the combination, fail to teach or suggest each and every element of claims 10, 11 and 16. Thus, these claims are not rendered obvious by the combination and are allowable.

Applicants respectfully request that, in view of the arguments presented above, claim rejections under 35 U.S.C. § 103 (a) be reconsidered, in light of the amendments, and withdrawn.

⁹ Wachob, Abstract

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4041 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 21 day of May 2008.

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